

REMARKS/ARGUMENTS

Applicants have amended claims 41, 42, 54, 65 and 66, and have added new claims 76-80. Claims 39-48, 52-59, 65-69, 76-80 are presently pending in the application.

Regarding particulars of the outstanding Office Action, it objected to Applicants' July 20, 2006 and August 8, 2007 amendments under 35 U.S.C. 132(a) for allegedly introducing new matter. In particular, the Office Action stated that "the presumption and assertion that the priority of 60/064,465 is inherent" "is not supported as by the original disclosure" and thus new matter. Applicants are unsure of the Examiner's concern and invite him to restate it or contact the Applicants by phone to explain, but for now it is noted that the current application clearly contains a valid incorporation-by-reference of the entire contents of Application 09/188,072. Furthermore, Application 09/188,072, in turn, clearly contains a valid incorporation-by-reference of the entire contents of Provisional Application 60/064,465, as indicated by the attached Exhibit A.

Regarding the statement on page 3 of the Office Action that "these determinations ... are now considered prior art," Applicants disagree and submit that such is not the case. Applicants have not admitted any of the mentioned to be or as containing prior art.

In connection with the prior-art rejections of the claims, claims 39-46, 48, 52, 53 and 65-68 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Rizoïu et al. (International Publication No. WO97/07928) in combination with Paolini et al. (U.S. Patent No. 6,206,873), Massengill (U.S. Patent No. 6,106,516), and allegedly "admitted prior art of ... removal of fat ... sterile fluids ... plastics ... and ... steel"; and claims 47, 54-59 and 69 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Rizoïu et al. in combination with Paolini et al., Massengill, and allegedly "admitted prior art of ... removal of fat ... sterile fluids ... plastics ... and ... steel" as applied to claims 39-46, 48, 52, 53 and 65-68 and further in view of Kittrell et al. (U.S. Patent No. 4,913,142). These rejections are respectfully traversed.

Applicants have amended the subject independent claims, however, to focus on an intended use of the current invention and its associated architecture. Namely, the Applicants' current invention is useful for tunneling through cartilage and, especially, hard tissue (e.g., bone).

The Examiner's attention is directed, for example, to the Summary section of the current application which describes how the invention can be used in arthroscopic surgical procedures in the treatment of, among other things: (i) torn menisci, anterior cruciate, posterior cruciate, patella malalignment, synovial diseases, loose bodies, osteal defects, osteophytes, and damaged articular cartilage (chondromalacia) of the knee; (ii) synovial disorders, labial tears, loose bodies, rotator cuff tears, anterior impingement and degenerative joint disease of the acromioclavicular joint and diseased articular cartilage of the shoulder joint; (iii) synovial disorders, loose bodies, osteophytes, and diseased articular cartilage of the elbow joint; (iv) synovial disorder, loose bodies, ligament tears and diseased articular cartilage of the wrist; (v) synovial disorders, loose bodies, labrum tears and diseased articular cartilage in the hip; and (vi) synovial disorders, loose bodies, osteophytes, fractures, and diseased articular cartilage in the ankle. According to the Summary, the current invention can be applied to precisely and cleanly shave, reshape, cut through or remove cartilage, fibrous cartilage, or bone.

Consistent with these uses, the cannula does not need to possess a leading tip that is shaped to pierce, cut, or disrupt the tissue, and, instead, according to a preferred implementation, the laser and fluid can do at least part, and, in typical applications, substantially all, of the cutting, with the cannula distal end emitting such items (the laser and fluid) to effectuate tunneling of the device through the tissue.

In contrast, it is noted that the device of Paolini has a sharpened tip whereby the cannula itself pierces, cuts, and disrupts tissue. For comparison, the Examiner's attention is directed to Figures 9b and 11b of the current application that contain images of this preferred blunt-tip implementation of Applicants' invention.

The Applicants determined, and, accordingly, designed, the architecture of the currently-claimed device to have an interaction zone positioned off-axis to the central (longitudinal) axis of the cannula so that during tunneling through, for example, cartilage or hard tissue such as bone the cannula can be rotated about its axis to

generate a “tunnel” sufficiently sized in width to allow the cannula to be advanced therethrough.

As presently amended, the independent claims pending in this application recite, for example, “the transmitter axis being (a) non-identical to, (b) non-overlapping with and (c) closer to the inner wall surface than the cannula axis” (claim 54), “the transmitter axis being disposed closer to the inner wall surface than to the cannula axis” (claim 65), and “a transmitter axis positioned closer to the inner wall surface than the cannula axis” (claim 66).

It is respectfully submitted that the current independent, amended claims are neither anticipated by nor obvious in view of the prior art of record, and thus are allowable over the prior art of record. It is submitted that each of the presently pending dependent claims is allowable at least because of their dependency upon its independent, amended claim, and further because of the additional limitations recited in therein.

Reconsideration and withdrawal of the rejections under 35 U.S.C. 103(a) is respectfully requested.

Applicants submit that the application is now in condition for allowance, and an early indication of same is requested.

Should the Examiner believe that a telephone conference with Applicants’ representative would be helpful to advance the prosecution of the application, or for any other reason, he or she is kindly invited to contact the undersigned with any questions.

The Commissioner is hereby authorized to charge any needed fees to deposit account 50-1600.

Respectfully submitted,



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